



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,867	03/13/2006	Heike Gielen-Haertwig	Le A 36 253	2121

35969 7590 05/05/2009
Barbara A. Shimei
Director, Patents & Licensing
Bayer HealthCare LLC - Pharmaceuticals
555 White Plains Road, Third Floor
Tarrytown, NY 10591

EXAMINER

DAVIS, ZINNA NORTINGTON

ART UNIT	PAPER NUMBER
----------	--------------

1625

MAIL DATE	DELIVERY MODE
-----------	---------------

05/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,867	Applicant(s) GIELEN-HAERTWIG ET AL.	
	Examiner Zinna Northington Davis	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-14, 16, 18, and 20 are pending.
2. Claims 15, 17, and 19 have been cancelled.
3. In the response filed March 2, 2009, Applicants have elected Group I, claims 1-14 and 16, with traverse.

Response to Applicants Remarks about The Improper Restriction Requirement

Applicants state the traversal is on the basis that a search for the compound of Group I would necessarily result in discover of any method of treatment. The search and examination of both groups can be made without undue burden on the Examiner.

It is the Examiner's position that:

- The compounds of formula I are drawn to independent and patentably distinct subject matter.
- The methods of using the compounds of formula I are drawn to independent and patentably distinct subject matter.
- See claims 18 and 20, which discloses multiple uses, which are not related.
- Under MPEP 806.05(h), the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

Art Unit: 1625

process of using that product. In this instance, the product as claimed can be used in a materially different process of using that product.

- There is an undue burden is to search the entire scope of claims when multiple inventions are claimed.
- The requirement is still deemed proper.
- The requirement is therefore made FINAL.

4. Claims 18 and 20 are withdrawn from consideration. These claims have not been canceled.

5. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A. It is suggested that the term “general” should be deleted.
- B. Claim 16 is improperly multiply dependent.
- C. Claim 16 depends upon two claim sets which is improper.

Art Unit: 1625

D. At claim 16, it is suggested that the phrase “characterized in that” should be amended to read as “wherein”.

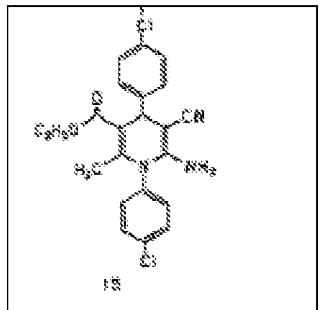
8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 6-10, 13, 14, and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Erian et al (Reference R1, cited by Applicants).

The instantly claimed compound is disclosed. At page 749, Scheme 13, see compound 15. The compound is depicted below:

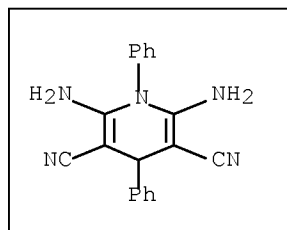


The claims are fully met when A = aryl ring wherein R¹ or R² is substituted by halogen; R⁷ and R⁸ are hydrogen; R⁵ = CH₃; R⁶ = CN; R⁴ = -C(O)Oalkyl; Y¹, Y², Y⁴, and Y⁵ are CH; and R³ or R⁹ is halogen.

10. The Information Disclosure Statement filed February 25, 2005 has been considered.

Art Unit: 1625

11. Reference U is cited to show the state of the art. At page 248, Scheme 1, see



compound 5. The compound is depicted below:

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682.

13. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Zinna Northington Davis/
Zinna Northington Davis
Primary Examiner
Art Unit 1625